

## **REMARKS/ARGUMENTS**

Applicant responds herein to the Office Action dated June 5, 2009.

Claims 1-17 remain pending in the most recent Office Action. Claim 8 has been withdrawn from consideration pursuant to Examiner's Restriction Requirement, and Applicant's election. Favorable reconsideration is kindly requested.

### **Rejection under 35 U.S.C. § 102**

Claims 1, 3 and 12 are rejected under 35 U.S.C. § 102(e) as anticipated by Kimura, et al. (2002/0135891). Applicant respectfully traverses the rejection for at least the following reasons.

Independent claims 1 and 12 are amended herein to include the features of claims 2 and 13, respectively, previously dependent therefrom. Claims 2 and 13 are cancelled without disclaimer or prejudice. Therefore, without acquiescing to the propriety of the rejection, Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

### **Rejection under 35 U.S.C. § 103**

Claims 2, 4-6, 9-11 and 13 are rejected under 35 U.S.C. § 103(a) as obvious over Kimura in view of Minoura (4,139,267). Applicant respectfully traverses the rejection for at least the following reasons.

Looking first to the Office Action's "Response to Arguments" (p. 8-9), the Office Action avers that no new arguments were presented, and the arguments "amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patenably distinguished the references." Applicant respectfully disagrees. In the amendment filed April 9, 2009, the claims were amended to specify that the recited aberration correction optical element is a passive aberration correction optical element. It was noted in the remarks that "[T]he aberration correction optical elements in the cited reference are not passive, but active optical elements." The most recent Office Action, for the first time, alleges that the aberration correction optical elements of Kimura are passive. Therefore, the Office Action itself saw the need to alter its rejection, at least so much as to address the distinctions raised in Applicant's remarks. Applicant respectfully traverses the mischaracterization of the arguments made as a "general allegation" of patentability without specificity.

Turning to the merits of the claims, as amended above, claim 1 incorporates from dependent claim 2 "said plurality of different passive aberration correction optical elements

provide correction for mutually different types, signs, and quantities of aberration.” Claim 12 as amended recites a corresponding aspect previously recited in claim 13 in a method of manufacturing an optical head device. The Office Action acknowledges that these features are not taught or suggested by Kimura. Rather, the Office Action avers that they are taught by Minoura, and further that it would have been obvious to combine the two references to obtain the features of amended claims 1 and 12. Applicant respectfully disagrees.

Initially, the Office Action apparently misapprehends the relevant features. The claims recite “said plurality of different passive aberration correction optical elements provide correction for mutually different types, signs, and quantities of aberration”. The term “mutually different types, signs and quantities” specifies that one optical element of the plurality does not correct for more than one types, signs, or quantities or aberration. As disclosed in the instant specification, in order to efficiently correct for aberration which varies from one such optical head device to another, a plurality of such aberration correction optical elements is provided. According to the method of claim 12, optical correction elements are selected from said plurality according to results of a measured aberration. In the head according to claim 1, one or more such elements are selected from said plurality. The recited plurality of elements enable whatever types, signs and quantity of aberration as may appear from one such unit to another may be corrected simply, quickly, efficiently.

These features are not present in Minoura. The Office Action cites to Col. 4, Table 1 of Minoura as disclosing “providing a plurality of different passive aberration correction optical elements, which correct for different types, signs and quantities of aberration.” (Office Action, p. 4). Minoura does not disclose “passive aberration correction optical elements structured to provide correction for mutually different types, signs, and quantities of aberration”, nor does the Office Action assert this to be the case.

Moreover, Minoura cannot meet this feature of independent claims 1 and 12. According to Minoura “Table 1 shows the aberration coefficients in the Examples 1 to 4.” (Col. 3, lines 30-31). The examples in question are described having a first positive lens or lens group (I), a second negative lens (II), and a third positive lens (III). On the other hand, Table 1 discloses coefficients for 14 different types of aberration. It cannot be the case, with only three or at most four such optical correction elements, that each element “provide[s] correction for mutually different types, signs, and quantities of aberration” that total 14 coefficients of correction.

Rather, Minoura at most discloses a complex, compound corrective elements which are obviated according to the present claims.

Therefore, even presuming that there were some apparent reason to combine the references as proposed in the Office Action, their proposed combination does not teach all features of present claims. It remains well-settles that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant respectfully submits that independent claims 1 and 12 are therefore patentably distinguished over Kimura and Minoura, taken singly or in combination.

Claims 3-7, 9-11 and 15-17 each depend from independent claim 1. Claim 14 depends from independent claim 12. These dependent claims are each separately patentable, but in the interest of brevity they are offered as patentable for at least the same reasons as their respective underlying independent base claims, the features of which are incorporated by reference. Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

Claim 7 is rejected under 35 U.S.C. § 103(a) as obvious over Kimura in view of Abe (6,084,843). Claim 14 is rejected under 35 U.S.C. § 103(a) as obvious over Kimura in view of Sano (6,967,916). Claims 15-17 are rejected under 35 U.S.C. § 103(a) as obvious over Kimura in view of Ogawa (5,126,994). Applicant respectfully traverses the rejections, for at least the following reasons.

Each of claims 7 and 14-17 depend from either independent claim 1 or 12, and incorporate by reference the features of their underlying independent base claims. None of Abe, Sano or Ogawa are alleged to remedy the above noted deficiencies of Kimura and Minoura with respect to these underlying independent base claims, as amended, namely including the features of prior claims 2 and 13. Therefore, even presuming that there were some apparent reason to combine the references as proposed in the Office Action, their proposed combination does not teach all features of present claims. See, *Royka, supra*. Applicant respectfully submits that claims 7 and 14-17 are therefore patentably distinguished over Kimura Abe, Sano and Ogawa, taken singly or in combination. Favorable reconsideration and withdrawal of the rejection is kindly requested.

**Conclusion**

In view of the foregoing, it is respectfully submitted, the claims of record clearly differentiate from and are patentable over the art of record.

Early and favorable consideration of the present application is earnestly solicited.

THIS CORRESPONDENCE IS BEING  
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Respectfully submitted,



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